Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK V. SMITH and JESSE M. CARTER

Appeal No. 1997-2149
Application No. 08/019,666

ON BRIEF

Before HAIRSTON, FLEMING, and GROSS, Administrative Patent Judges.

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, and 5, which are all of the claims pending in this application.

Appellants' invention relates to an emergency auto visual communication system which displays a message to an observer

from the interior of a vehicle. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. An emergency auto visual communication system for advisement from vehicle to observer, comprising:

a direct current (DC) to alternating current (AC) power converter that is inserted into the vehicle's cigarette lighter socket or wired directly to the battery of the vehicle;

a computer with keyboard that controls and communicates to an illuminated electronic display (LED);

said illuminated electronic display (LED) that attaches to the rear, front, or side windows of the vehicle allowing a message to be displayed on the illuminated electronic display that can be seen through the window.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Katogi et al. (Katogi)	4,752,771	Jun. 21, 1988
Reiser	4,928,084	May 22, 1990

The prior art reference relied upon by the Board in rejecting the appealed claims is:

Fahs	5,132,666	Jul. 21, 1992

Claims 1, 2, and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Reiser in view of Katogi.

Reference is made to the Examiner's Answer (Paper No. 29, mailed April 15, 1996) and the Supplemental Examiner's Answer (Paper No. 31, mailed September 4, 1996) for the examiner's complete reasoning in support of the rejection, and to appellants' Brief (Paper No. 27, filed March 27, 1996) and Reply Brief (Paper No. 30, filed June 12, 1996) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 1, 2, and 5.

"'[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable.'" In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, The Extent of the Protection and Interpretation of Claims --American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)). In interpreting claims, "limitations are not to be read into the

claims from the specification." In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Thus, the first step in any patentability analysis is to determine exactly what is claimed. Here, claim 1 requires (1) a light emitting diode display which attaches to a rear, front, or side window of a vehicle and can be seen through the window, (2) a computer with a keyboard for controlling the display, and (3) a DC to AC converter that either inserts into the vehicle's cigarette lighter or is wired directly to the battery of the vehicle. Claim 2 adds that an individual can send a message to the display by typing it into the computer keyboard and that the display is attached to the window via suction cups or an attachment mechanism. Claim 5 adds the benefit of an individual's not having to exit the vehicle to communicate to an observer.

Reiser is directed to a combined message display and brake light. Appellants argue (Brief, page 4 and Reply Brief, page 2) that their claims do not require braking and (Brief, page 5) that the examiner "uses hind-sight reconstruction to suggest that one having ordinary skill in the art would

eliminate the braking requirement of Reiser." Although we agree with appellants that elimination of Reiser's braking requirement would not have been obvious to the skilled artisan, as doing so would run contrary to the teachings of Reiser, the examiner has not suggested eliminating Reiser's braking requirement. Instead the examiner explains (Answer, page 5) that since nothing in the claims requires the absence of a braking requirement, the claims do not preclude a requirement for braking. Accordingly, Reiser's combined display and brake light meet the language of appellants' claims.

Reiser's message is displayed through the rear window to an observer outside the vehicle (thereby meeting the limitation of claim 5). In particular, Reiser discloses (column 1, line 60 - column 2, line 12) a display panel of light emitting diodes (LEDs) detachably secured to the rear window of a vehicle on the passenger side via suction cups. Thus, Reiser discloses the claimed display and the details thereof, as well as the attachment method recited in claim 2. Appellants argue (Brief, page 4 and Reply Brief, page 3) that Reiser "does not mention the option of mounting of the Reiser

device on any surface or location on the vehicle." Again we look to the claims. Claim 1 uses the alternative language "rear, front or side windows of the vehicle" (emphasis added). Thus, a reference need only satisfy one of the three alternatives, or rather, disclose one location, to meet the claims. Reiser meets the rear window alternative of the claims. Therefore, appellants' argument is not persuasive.

Appellants also assert (Brief, page 4 and Reply Brief, pages 4-5) that Reiser "does not claim the ability to display multiple colors." Viewing appellants' pending claims, we find no mention of color. Therefore, Reiser's red display is sufficient to meet the claims.

Reiser's display is controlled by a CPU and memory (see column 2, lines 22-24). Reiser states (column 4, lines 37-45) that messages to be displayed by the LEDs are stored in the memory and "[a] selected one of the individual messages is extracted from memory by the control unit 16 under a command received from a message selector 32 ... provided with a keyboard having manually operable control buttons." Thus, Reiser discloses the claimed computer and keyboard, as well as the user's ability to enter a message as recited in claim 2.

Appellants contend (Reply Brief, page 2) that Reiser's message cannot be changed once the message is selected. Once again we look to the claims, and we find no requirement that the message be changeable once selected. The claims merely recite that the individual must be able to enter a message via the keyboard. As claimed, such entry could be only once, when the message is initially selected. Therefore, the claims do not require that the user be able to change the message.

As to the last element of the claims, although Reiser states (column 3, lines 51-52) that electrical power is supplied to the computer and the display from a power supply such as the vehicle battery, Reiser does not mention a DC to AC converter. The examiner applies Katogi to show that DC to AC power converters are well-known in the art "for supplying AC power from the existed [sic] DC power supply to an accessory" (Answer, page 3). The examiner concludes, therefore, that it would have been obvious to use a well-known DC/AC converter to supply power from the vehicle battery to the display.

Appellants (Brief, pages 5-6) contest the combinability of Katogi with Reiser. We agree that Katogi does not provide

sufficient motivation for modifying Reiser. Katogi discloses a liquid crystal instrument panel for a vehicle with a fluorescent backlight. In column 7 Katogi discusses using a DC/AC converter to supply AC voltage to the fluorescent lamp. Nowhere, however, does Katogi suggest a need for a DC/AC converter for an LED display such as the one disclosed by Reiser. Although we agree with the examiner that such converters are well-known, there must be a reason in the references as to why one would be motivated to modify the display of Reiser to include a DC/AC converter. As we find no such motivation, we cannot sustain the rejection.

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against appellants' claims 1, 2, and 5:

Claims 1, 2, and 5 are rejected under 35 U.S.C. § 103 as being unpatentable over Reiser in view of Fahs.

Reiser discloses all of the claimed invention except for a DC/AC converter, as explained in detail above. Fahs relates to a vehicle mounted LED display that is controlled by a computer processor from inside the vehicle and powered by the car battery. (See column 1, line 64-column 2, line 5 and

column 2, line 65). Fahs teaches (column 3, line 62-column 4, line 7) that when the vehicle is stationary, power can be provided from an external power source. However, when the vehicle is moving, a DC/AC inverter is used to provide the necessary wattage from the vehicle battery to the computer processor and display screens. Since Reiser uses the same type of display as Fahs and powers the display using the vehicle battery (column 3, lines 51-52), it would have been obvious to include a DC/AC inverter for providing the necessary wattage from the vehicle battery, as suggested by Fahs. Consequently, claims 1, 2, and 5 would have been obvious over Reiser in view of Fahs.

CONCLUSION

The decision of the examiner rejecting claims 1, 2, and 5 under 35 U.S.C. § 103 is reversed. A new ground of rejection of claims 1, 2, and 5 under 35 U.S.C. § 103 has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR §

1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED
37 CFR § 1.196(b)

KENNETH W. HAIRSTON Administrative Patent Judge	)
MICHAEL R. FLEMING Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)

apg/vsh

JACK V. SMITH
P.O. BOX 5895
ASHEVILLE, NC 28813